

Application No. 09/823,920
Paper filed February 28, 2006
Reply to Office Action mailed December 19, 2005

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REMARKS

Status Summary

Claims 1-2, 4-17, 21-23, 25-37, and 41 are pending in the present application, of which claims 1, 21, and 41 are presented in independent form. Claims 1-2, 4-17, 21-23, 25-37, and 41 stand rejected.

Claim Objection(s)

The claims have been amended merely to address informalities raised in the Action under the rules of the Office. Thus, these amendments were made for reasons unrelated to the statutory requirements for a patent and have not narrowed the scope of the claims. Accordingly, the amendment of these claims does not raise any presumptions regarding, nor trigger the application of the doctrine of prosecution history estoppel to limit the range of equivalents.

In particular, claim 34 would be amended to no longer depend from cancelled claim 24 and to properly depend from claim 21. Claim 35 remains dependant on claim 34. Accordingly, applicant respectfully requests that the Examiner enter this Amendment, at least for the limited purpose of Appeal, such that claims 34-35 would depend from a pending claim.

Claim Rejection(s) - 35 U.S.C. § 103

Claims 1-2, 4, 6-7, 10, 13-17 21-23, 26-27, 36-37 and 41 stand rejected as being unpatentable over U.S. Patent No. 6,587,839 to McIntyre et al (hereinafter "McIntyre"), in view of U.S. Patent No. 6,701,302 to Schaeffer et al (hereinafter "Schaeffer") and further in view of U.S. Patent No. 6,587,596 to Haeberli (hereinafter Haeberli). Claims

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5, 9, 25, and 29 stand rejected as being unpatentable over McIntyre, Schaeffer, and Haeberli, in further view of U.S. Patent No. 6,636,733 to Helferich (hereinafter Helferich). Claims 8, 11-12, 28, and 31-33 stand rejected as being unpatentable over McIntyre, Schaeffer, and Haeberli, in further view of U.S. Patent No. 6,570,583 to Kung et al (hereinafter Kung). Claim 41 is not discussed in the Office Action, but is listed as rejected on the Office Action Summary. As claim 41 includes the limitations found in claims 11 and 12, Applicant applies the rejections of claims 11 and 12 to claim 41.

Claim 41 is directed to a method relating to photographic film processing. None of the references, alone or in combination, cited in the Office Action disclose each and every element of claim 41. For example the method includes:

displaying an icon on said first cell phone display, wherein the selection of said icon automatically causes said first cell phone to be communicatively connected with said service facility, such that an instruction is sent to a computer at said service facility for requesting that the consumer's job data be placed on a computer monitor screen so that when a lab attendant picks up a phone, the job attendant has substantially immediate reference to the job.

The Office Action cites Kung and McIntyre as anticipating this element of the claim. Kung is said to disclose iconic information for selection. Kung states: "The icon is used to inform the user which telephone number will be called when a call button is pressed on the input panel." (Column 3, lines 25-26) Kung does not disclose the selection of the icon sending an instruction to the computer at said service facility for requesting that the consumer's job data be placed on a computer monitor screen as claimed in Claim 41. The Office Action further cites McIntyre as disclosing an instruction sent to a computer at said service facility. McIntyre states: "the visual displays contain an order identification code 108 to assist the customer in retrieving their order at retailer 23." (Column 8, lines 15-17). It is clear that in McIntyre the visual displays containing the identification code are user displays. These displays are not related to the job attendant ability to reference a job. Thus, McIntyre and Kung, alone or

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in combination, do not disclose sending an instruction to a computer at a service facility to display job data on a computer monitor screen so that the job attendant has substantially immediate reference to the job.

Accordingly, since the cited documents fails to disclose or suggest all of the claim limitations for at least the above reasons, applicant respectfully requests the obviousness rejections of claim 41, 11, and 12 be withdrawn.

Claims 1 and 21 stand rejected in view of McIntyre in view of Schaeffer and further in view of Haeberli. Applicant respectfully asserts that the combination of these references is improper. The office action states:

McIntyre, Schaeffer, and Haeberli are combinable because they disclose photographic prints. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include user adjustments to process print orders in the system of McIntyre and Schaeffer as disclosed by Haeberli. The suggestion/motivation for doing so would have been allowing user more interaction when editing (note col. 3 lines 20-25).

Applicant respectfully disagrees. Allowing a "user more interaction when editing" provides no suggestion or motivation to combine Haeberli with McIntyre and Schaeffer. Neither McIntyre nor Schaeffer is directed to editing images. McIntyre makes no reference at all to editing images. Schaeffer and McIntyre are directed to systems for notifying consumers of ready print orders and for the distribution of images. One of ordinary skill in the art would have had no motivation to combine Haeberli with either Schaeffer or McIntyre at least because Schaeffer and McIntyre aim to solve different problems than Haeberli. Haeberli is not subject to notifying a user that a print order is ready, which is the problem McIntyre was trying to solve, and thus it is hard to understand why one knowing McIntyre and Schaeffer would have been motivated to look to Haeberli for anything. Moreover, the Action's suggestion that the documents can be combined ignores the great technical differences between Haeberli and Schaeffer and McIntyre that would have made such a combination improbable to say the least.

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Applicant asserts that allowing a user more interaction when editing provides no suggestion or motivation to combine Haeberli, McIntyre, and Schaeffer.

The section cited by examiner as providing motivation is directed to providing buttons for user interaction. The cited section states:

Optionally, the control can be a button that allows the user to change the shape of the selected portion of the image, a button that allows the user to zoom the selected portion of the image, or a button that allows the user to move the selected portion of the image.

Applicant asserts that the disclosure of control buttons in Haeberli provides no motivation to combine the reference with either Schaeffer's or McIntyre's system for processing print orders. More particularly, the disclosure in Haeberli of buttons that allow for user interaction on a browser-based photo-editing system would not have motivated one of ordinary skill in the art to combine Haeberli with the print order processing systems of Schaeffer or McIntyre. Applicant asserts there is no motivation or suggestion to combine Haeberli with Schaeffer and McIntyre.

Further, even if a motivation to combine the references existed, the proposed combination of Haeberli with McIntyre and Schaeffer would change the principle of operation of Haeberli. As discussed above Haeberli is directed to a browser based photo-editing system. Examiner reads the print order processing systems of McIntyre and Schaeffer are directed to distributing images and notifying consumers on a portable device of a ready print order. If combined with Schaeffer and McIntyre, the principle of operation of Haeberli would be changed. Haeberli would no longer operate as a browser based photo editing system allowing user interaction. Rather, Haeberli would be reduced to providing minimal edits with minimal user interaction. Thus, applicant respectfully asserts the combination of the references is improper.

Applicant respectfully asserts that the only manner in which Haeberli could be combined with Schaeffer and McIntyre would be through an improper hindsight reconstruction. In determining the differences between the prior art and the claims, the

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question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. See MPEP 2141.02, Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); Schenck v. Nortron Corp., 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

Moreover, "[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103." See MPEP 2141.02, In re Sponnoble, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969).

The invention as a whole should therefore be considered as well as the identified problem the invention as a whole is solving. Here, the Examiner has not cited any documents that disclose or suggest providing a user with a notification of the development of film including the developed images, and allowing the user to modify the developed images, and placing an order for prints including the modified images. There is nothing in the cited documents that even contemplates solving this problem. The selection of independent sections of each of the references to read on the elements of the claims of the instant invention is improper. As stated above, there is no motivation to combine the cited references, and if combined the result would be an inoperable system. As such, applicant respectfully asserts the combination of the references is improper.

Haeberli further discusses providing for interaction with a user on col. 23 lines 58-65:

To provide for interaction with a user, the invention can be implemented on a computer system having a display device such as a monitor or LCD screen for displaying information to the user and a keyboard and a pointing device such as a mouse or a trackball by which the user can provide input to the computer system. The computer system can be

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programmed to provide a graphical user interface through which computer programs interact with users.

This section of Haeberli teaches away from combining Haeberli with the system of McIntyre and Schaeffer. As examiner states, McIntyre and Schaeffer disclose using a cell phone to receive an email message containing the images. Haeberli teaches that a mouse is included in the system to provide for interaction with the user. The portable devices of McIntyre and Schaeffer would be unable to receive input from a mouse in order to allow user interaction. The process of editing images disclosed in Haeberli requires a level of interaction not provided for in McIntyre and Schaeffer. As such, combining the editing functions taught by Haeberli with the image processing systems of McIntyre and Schaeffer would result in an inoperable system. Thus, the combination of references is improper.

Accordingly, Applicant asserts that the combination of documents relied upon to support the obviousness rejection of claims 1 and 21 is improper, and respectfully requests the claim rejection be reconsidered and withdrawn for this reason also. Furthermore, rejected claims 2, 4, 6-7, 10, 13-17 22-23, 26-27, 36-37 are novel and inventive for at least the same reasons.

CONCLUSION

In view of the above, it is respectfully submitted that the present application is now in proper condition for allowance, and an early notice to such effect is earnestly solicited. Entry and favorable consideration of the above amendments and remarks is also respectfully requested. The Examiner is respectfully requested to telephone the undersigned patent attorney at the below-listed number if, after reviewing the above Remarks, the Examiner believes outstanding matters remain that may be resolved without the issuance of a subsequent Official Action.

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DEPOSIT ACCOUNT

The Commissioner is hereby authorized to charge any fees associated with the filing of this paper to Deposit Account No. 50-3512 (IPAC, LLC).

Respectfully submitted,

Date: February 28, 2006

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